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PATENT

Atty Docket No.: 200208398-1

App. Scr. No.: 10/685,742

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks.

By virtue of the amendments above, claims 1, 4, 5, 7, 11, 18, 19, 23, 27, 29 and 30 have been amended. Support for the amendments may be found in the original claim 19 and original specification at paragraph 21, lines 4-8, and paragraph 23, lines 6-8. Accordingly, claims 1-30 are pending in the present application of which claims 1, 7, 18, 27, and 30 are independent.

Claims 1-3, 7-13, 15, 17-25, and 27-30 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,879,600 to Jones et al. ("Jones").

Claims 4-6, 14, and 24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones in view of U.S. Patent No. 6,776,334 to Garg ("Garg").

Claims 16 and 26 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones in view of U.S. Patent Publication No. 2002/0194141 to Langensteiner et al. ("Langensteiner").

Drawings

The indication that the Drawings submitted on October 15, 2003 have been approved is noted with appreciation.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed

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combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-3, 7-13, 15, 17-25, and 27-30

Claims 1-3, 7-13, 15, 17-25, and 27-30 were rejected under 35 U.S.C. §102(b) as being anticipated by Jones. It is noted that, while claim 24 was included in the foregoing rejection, it appears that claim 24 should not have been indicated as being rejected under the foregoing rejection for the following reason. The body of the foregoing rejection in the Office Action at pages 2-6 does not specifically mention claim 24. However, the body of the rejection of claims 4-6, 14, and 24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones in view of Garg at pages 6-7 of the Office Action does specifically mention claim 24.

Independent claim 1 has been amended to recite a method comprising, inter alia, wirelessly transmitting within a second area and by using a line-of-sight beacon information needed by a wireless device to gain access to a local area network.

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It is respectfully submitted that Jones fails to teach the above recited features. Jones is directed to a mobile station that provides arbitration and hand-off between two or more differently formatted computer and/or telecommunication networks. Abstract of Jones, lines 1-3. However, Jones fails to show wirelessly transmitting, within a second area and by using a line-of-sight beacon, information needed by a wireless device to gain access to a local area network.

For at least the foregoing reasons, Jones fails to teach all of features of independent claim 1 and its dependent claims.

Independent claims 7, 18, 27, and 30 have been amended to incorporate features similar to those discussed above for claim 1. Thus, for the reasons set forth earlier with respect to independent claim 1, Jones fails to teach all of features of each independent claims 7, 18, 27, and 30 and their respective dependent claims.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim

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must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

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Claims 4-6, 14, and 24

Claims 4-6, 14, and 24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones in view of Garg.

Claims 4-6, 14, and 24 are dependent from independent claims 1, 7, and 18, and for at least the reasons set forth earlier with respect to independent claims 1, 7, and 18, Jones fails to teach wirelessly transmitting within a second area and by using a line-of-sight beacon information needed by a wireless device to gain access to a local area network.

Garg fails to correct the above discussed deficiency of Jones.

The Office Action relies on Garg to show a line-of-sight beacon recited in amended claim 1. Specifically, the Office Action at page 7 states that "it would have been obvious to adapt the line-of-sight beacon, optical beacon, or infrared beacon of Garg to the method and system of Jones et al. to provide access to the local area network within a room or section of the building."

However, contrary to the above-assertion in the Office Action, Garg does not teach wirelessly transmitting, by using a line-of-sight beacon, information needed by a wireless device to gain access to a local area network.

Rather, in reference to Fig. 1, Garg teaches positioning infrared beacons 30(a)-30(d) within each room of the home 18 for generating a modulated infrared light signal, each of which has a unique signature pattern different from the signature patterns of other infrared beacons 30(a)-30(d), where because infrared illumination is blocked by typical walls, the regions around each infrared beacon 30 in which the signature pattern is detectable is typically limited to the room in which the infrared beacon 30 is located. Garg at column 5, lines 5-13. By using the unique signature pattern of each of the infrared beacons 30(a)-30(d),

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a monitoring appliance 28 is able to determine a location of a mobile unit 12 and activate an alarm if the mobile unit 12 is located in a particular location. Garg at column 5, lines 28-41.

An access to a network in Garg is performed by interactions through a mobile unit 12 and a wireless network access point 24. The infrared beacons 30(a)-30(d) merely use the established network access through the wireless network access point 24 for transmitting detected signature patterns for an alarm determination by the location monitoring appliance 28. Garg at column 5, lines 14-22. The infrared beacons 30(a)-30(d) are not used to provide access to a wireless local area network in another region.

Thus, it would not have been obvious for a person of ordinary skill in the art to use wirelessly transmitting, by using a line-of-sight beacon, information needed by a wireless device to gain access to a local area network in view of Garg since Garg does not teach such features as discussed above.

Further, even if Garg teaches wirelessly transmitting, by using a line-of-sight beacon, information needed by a wireless device to gain access to a local area network for the sake of argument, Jones teaches away from using a line-of-sight beacon of Garg to provide information for accessing an access system (either 112 or 118 in Fig. 1 of Jones) of Jones.

In reference to Figs. 1-2, Jones teaches a coverage area 202 of a first access system 112 and a coverage area 206 of a second access system 118, where a mobile station 116 traveling between the two coverage areas 202 and 206 may be provided with arbitration and handoff between the two access systems 112 and 118. Abstract of Jones, lines 1-8. However, using a line-of-sight beacon to provide information needed by a wireless device to gain access to one of the two access systems 112 and 118 would result in an unreliable access to the cellular network for the mobile station 116, because the mobile station 116 would only be

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able to access the cellular network when it is within the line-of-sight of a base station. Thus, the coverage of the cellular network would be significantly diminished.

Also, the coverage areas 202 and 206 created by BTS 422 and WAP 424 in Fig. 4 would be different from the areas where information for accessing the BTS 422 and 424 is provided. With such difference between the coverage areas 202 and 206 and areas where information for accessing the BTS 422 and WAP 424 is provided, the intended arbitration and handoff in the overlapping coverage areas 202 and 206 for the BTS 422 and WAP 424 in the Jones' system would not occur smoothly, for example, if the respective access areas for the BTS 422 and WAP 424 do not overlap at all.

Thus, Jones teaches away from using a line-of-sight beacon of Garg to provide information for accessing an access system of Jones.

For at least the foregoing reasons, Jones would not be combinable with Garg as suggested in the Office Action, and the proposed combination of Garg and Jones fails to teach or fairly suggest all of features of claims 4-6, 14, and 24.

Claims 16 and 26

Claims 16 and 26 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones in view of Langensteiner.

Claims 16 and 26 are dependent from independent claims 7 and 18, respectively, and for at least the reasons set forth earlier with respect to independent claims 7, and 18, Jones fails to teach a method comprising, inter alia, wirelessly transmitting within a second area and by using a line-of-sight beacon information needed by a wireless device to gain access to a local area network.

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Langensteiner fails to correct the above discussed deficiency of Jones.

For at least the foregoing reasons, the proposed combination of Jones and Langensteiner fails to teach or fairly suggest all of features of claims 16 and 26.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103 with respect to claims 4-6, 14, 16, 24, and 26.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 4-6, 14, 16, 24, and 26 and to allow these claims.

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In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: June 9, 2008

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